

REMARKS

Claims 1-27 are subject to restriction and/or election requirement.

Claims 1 and 15 are amended, based on claims 1 and 15 as originally filed.

Claims 1-27 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Restriction under 35 USC § 121:

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121: Group I. Claims 1-14, 25-27, drawn to a color-coded bead comprising a photochromic compound in a medium, the bead having receptor on its surface, classified in class 436, subclass 525; Group II. Claims 15-21, drawn to a microarray of color coded bead comprising a support, classified in class 436, subclass 518; Group III. Claims 22-24, drawn to a method of using the microarray, classified in class 436, subclass 501, as the inventions are distinct, each from the other because of the Inventions I and II are related as combination and subcombination and, in the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the color coded bead does not require the solid phase of the microarray (subcombination) and the subcombination has separate utility such as immobilizing or detecting a plurality of target biomolecules or fractionating sample into a smaller volume using the solid phase, Inventions I and III are unrelated, since, in the instant case, the different inventions are not usable together because the assay of invention III cannot be used with a single color coded bead, but rather a microarray of those beads on a solid support and the color coded bead can not be used in the assay of invention III because it is not attached to a solid phase; and while the Inventions II and III are related as product and process of use, the inventions are distinct, since, in the instant case the product can be used in a different process such as separation of different populations of biomolecules in a sample mixture.

The Applicants elect the invention of Group I, with traverse.

With respect to the inventions of Group I and Group II: As indicated by the Examiner, Inventions I and II are related as combination and subcombination. Also, as noted by the Examiner, MPEP 806.05(c) Criteria of Distinctness Between Combination and Subcombination states that *"To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary,*

i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.” MPEP 806.05(c) I. SUBCOMBINATION

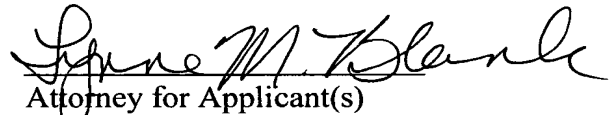
ESSENTIAL TO COMBINATION AB^{sp}/B^{sp} indicates that, restriction is not proper “Where a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that combination AB^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB^{sp}, and subcombination B^{sp}. Thus the specific characteristics required by the subcombination claim B^{sp} are also required by the combination claim.” In the present situation, claim 1 of Group I, the subcombination B^{sp}, is for a color coded bead for use in a microarray for detecting target analytes, the bead comprising a photochromic compound in a medium, the bead having a receptor molecule on its surface; wherein the photochromic compound confers on the bead a distinct optical signature; and wherein the receptor molecule is capable of binding to a target analyte, and claim 15 of Group II, the combination AB^{sp}, is to a microarray comprising a support (A), and the beads of claim 1 (B^{sp}). The only difference between the invention of claim 1 and the invention of claim 15 is the addition of the support, and *“Thus the specific characteristics required by the subcombination claim B^{sp}”, here, claim 1 to the beads, “are also required by the combination claim”, here, claim 15 to the beads and a support.”* According to MPEP 806.05(c) I, *“The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.”*

With regard to Group III: As noted by the Examiner, Inventions II and III are related as product and process of use and the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process

of using that product. See MPEP § 806.05(h). Claim 22 of Group III requires and specifically states that the first step in the method is "providing the microarray of claim 15". Claim 22 also states that the method is used for identifying target analytes – the same language that appears in the body of amended claim 15. Therefore, the Applicants believe that the inventions are not distinct, since the specific language of the claims relates one exactly to another and specify the same use for the claims in each Group identified by the Examiner.

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,


Attorney for Applicant(s)
Registration No. 42,334

Lynne M. Blank/ct
Rochester, NY 14650
Telephone: 585-477-7418
Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.